UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,727	06/29/2001	Hsinchao Liao		8720

7590	12/29/2005

HSINCHAO LIAO
P. O. BOX 5644
BERKELEY, CA 94705-0644

EXAMINER
CHOWDHURY, SUMAIYA A

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/896,727	LIAO, HSINCHAO
	Examiner	Art Unit	
	Sumaiya A. Chowdhury	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-11,13 and 16-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-11,13 and 16-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/29/05 have been fully considered but they are not

persuasive.

(a) Applicant argues that "**Inoue's device does not personalize data...**" on page 17,

2nd paragraph, and that "**there is no means provided in Inoue to construct the**

device and personalization process claimed in the present invention" on page 17,

3rd paragraph, of the amendment filed 9/29/05.

In response, applicant should note that Inoue's device does personalize data.

See col. 10, lines 30-60. The receiver extracts the specific type of information desired

by the user. The desired data is stored on the memory device (100) belonging to the

user. Therefore, the stored data is personal to the user.

(b) Applicant argues that "**said device and program are neither specified nor**

claimed by Inoue to be capable of automatically identifying and displaying only

the stocks in the user's portfolio" on page 17, 2nd paragraph, of the amendment filed

9/29/05.

In response, applicant is arguing that which is not claimed. Applicant claimed

that the device personalizes data. Inoue's device personalizes data because (i) it

extracts information desired by the user such as map information or stock price

information – col. 10, lines 30-60; (ii) memory device (100) stores the desired data; and

(iii) the data is desired only by the user and does not involve other users. Furthermore,

"personalized" data is interpreted to be any data desired, related or associated with a

user.

(c) Applicant argues that "**Inoue specifies no process for producing suitable**

software or firmware compatible with the patented device to achieve any purpose,

whether or not the purpose is mentioned by Inoue" on page 17, 5th paragraph –

page 18, 1st paragraph, of the amendment filed 9/29/05.

In response, the process for producing suitable software or firmware is not

recited in the claim.

(d) Applicant argues that "**It is not obvious to any skilled person how Inoue's device**

can be built to conform to Sezan's schemes" on page 18, 2nd paragraph, of the

amendment filed 9/29/05.

In response to applicant's argument that "**It is not obvious to any skilled**

person how Inoue's device can be built to conform to Sezan's schemes", on page

18, 2nd paragraph, of the amendment filed 9/29/05, the test for obviousness is not

whether the features of a secondary reference may be bodily incorporated into the

structure of the primary reference; nor is it that the claimed invention must be expressly

suggested in any one or all of the references. Rather, the test is what the combined

teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Additionally, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sezan was brought in to teach a signaling means for alerting the user that demodulated data is available, video display comprising pacing means for displaying content with a plurality of pause lengths, pacing means including selection of pause lengths through software stored on said removable storage device, and synchronizing means for synchronizing parameters stored on removable storage device with the parameters used by an interactive television service.

(e) Applicant argues that "**Neither Inoue nor Shimakawa defines or discloses "personalization".**" on page 19, 1st paragraph, of the amendment filed 9/29/05.

In response, applicant should note that Shimakawa discloses wherein the receiver is programmed to receive desired programs from among a plurality of programs – col. 4, lines 60-65, col. 5, lines 13-20. Additionally, the receiver in Inoue's invention extracts the specific type of information desired by the user - col. 10, lines 30-60.

(f) Applicant argues that "**Hendricks' invention can be connected to a radio tuner**

via some interfaces such as cable. On the other hand, applicant's invention, as

claimed, is a personalization module embedded within a car stereo" on page 20,

3rd paragraph, of the amendment filed 9/29/05.

Applicant's arguments with respect to claim 9 have been considered but

are moot in view of the new ground(s) of rejection.

Claim Objection

2. In claim 13, line 1, "claim 12" should be changed to –claim 10--.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 5, 10, 11, 16, 19-22, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Inoue in view of Shimakawa.

As for claim 1, Inoue discloses a receiver comprising

(a) a broadcast tuner (10 – Fig. 1) that demodulates a broadcast program into a

plurality of data sets – (The tuner includes a demodulating section and a front-end

section (12 – Fig. 1) which converts the signals into digital signals - col. 6, lines 1-7);

and

(b) an embedded computer (30-45 – Fig. 1), operably linked to a removable

storage device (100 – Fig. 1, col. 8, lines 64-67), said removable storage device having

stored therein one or more personalization parameters (parameters stored in the

software program which enable extraction of specific type of information or objective

information) established prior to said removable storage device being linked to said

embedded computer (col. 10, lines 30-53), wherein said embedded computer can select

one or more data sets demodulated from said broadcast program according to the

personalization parameters (parameters in the software program which enable

extraction of specific type of information or objective information from the broadcast

signal for the specific user) and generate one or more outputs for each of the selected

data sets to the user (The user is outputted with user-specific information based on the

program which stores what type of information needs to be extracted for the particular

user - col. 10, lines 30-53).

However, Inoue fails to discloses a mobile receiver.

In an analogous art, Shimakawa discloses the reception of desired type of data

by a mobile data receiver. The receiver is controlled to receive a desired type of data,

for example, weather forecasts, news, stock prices, etc. – col. 8, lines 11-18.

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify Inoue's system to include a mobile data receiver, as

taught by Shimakawa for the advantage of providing mobility to the user.

As for claim 3, Inoue and Shimakawa disclose wherein said embedded computer

loads from said removable storage device software containing instructions for said

embedded computer to compute derivatives from the elements of the selected data

sets, and output said derivatives to the user. In particular, Inoue discloses the

embedded computer loads the program from the removable storage device. The

program is the software which contains the parameters (instructions) of the specific type

of data which needs to be extracted from the digital broadcasting waves by the

embedded computer to be displayed to the user. -- col. 10, lines 30-53.

Considering claim 5, Inoue and Shimkawa disclose an apparatus comprising a

video display for displaying digital data (Inoue - col. 8, lines 7-12).

As for claim 10, Inoue discloses a personalization system, comprising:

(a) an interactive computer (Fig. 1), for providing to the user an interactive

means for configuring one or more personalization parameters and for writing the

personalization parameters to a removable storage device (col. 10, lines 30-40, col. 16,

lines 62-67, col. 17, lines 1-3); and

b) A receiver comprising

(1) a broadcast tuner (10 – Fig. 1) that demodulates a broadcast program in to a plurality of data sets – col. 6, lines 1-7; and

(2) an embedded computer (30-45 – Fig. 1), operably linked to a removable storage device (External Memory 100 – Figure 1, col. 8, lines 64-67), said removable storage device having stored therein one or more personalization parameters written by said interactive computer prior to said removable storage device being linked to said embedded computer (The receiver (3) which is a component of the complete interactive system writes data in the external memory element 100 - col. 15, lines 18-21. The external memory element (100) stores a program for enabling extraction and use of the specific type of information (parameter) - col. 10, lines 30-40), wherein said embedded computer can select one or more data sets demodulated from said broadcast program according to the personalization parameters (parameters in the software program which enable extraction of specific type of information or objective information from the broadcast signal for the specific user) and generate one or more outputs for each of the selected data sets to the user (The user is outputted with user-specific information based on the program which stores what type of information needs to be extracted for the particular user - col. 10, lines 30-53).

However, Inoue fails to discloses a mobile receiver.

In an analogous art, Shimakawa discloses the reception of desired type of data by a mobile data receiver. The receiver is controlled to receive a desired type of data, for example, weather forecasts, news, stock prices, etc. – col. 8, lines 11-18.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Inoue's system to include a mobile data receiver, as taught by Shimakawa for the advantage of providing mobility to the user.

Considering claim 11, Inoue and Shimakawa disclose a system wherein said interactive computer is a television set top box (Inoue - col. 4, lines 45-50, col. 19, lines 41-44).

As for claim 16, Inoue discloses wherein said interactive computer (Fig. 1) includes a programming means for compiling instructions for said embedded computer (30-45-Fig. 1) to compute derivatives from the elements of the selected data sets demodulated from said broadcast program, and for writing said instructions to said removable storage device (The receiver (3 – Fig. 1) records data brought in from an external device (30-45 – Fig. 1) to the removable storage device (100 – Fig. 3). Additionally, programs and data (compiling instructions for said embedded computer to computer derivatives) stored in the external memory element are substituted for part of the programs and data stored in the flash memory (34 – Fig. 1) – Inoue, col. 19, lines 3-16).

As for claim 19, Inoue discloses a mobile receiver unit comprising:

(a) a broadcast tuner (10 – Fig. 1) that demodulates a broadcast program into a plurality of data sets – col. 6, lines 1-7;

(b) a filtering means for selecting one or more data sets demodulated from said

broadcast program by said broadcast tuner, according to one or more personalization

parameters (program which stores which information needs to be extracted from the

broadcast signal for the specific user) loaded from a removable storage device operably

linked to said mobile receiver (The user is outputted with user-specific information

based on the program which stores what type of information needs to be filtered for the

particular user - col. 10, lines 30-53).; and

(c) an output means (monitor receiver) for generating one or more outputs for

each of the selected data sets – col. 8, lines 6-12, col. 10, lines 45-50;

whereby said receiver is able to generate personalized outputs automatically and

continuously upon being linked to said removable storage device.

However, Inoue fails to discloses a mobile receiver.

In an analogous art, Shimakawa discloses the reception of desired type of data

by a mobile data receiver. The receiver is controlled to receive a desired type of data,

for example, weather forecasts, news, stock prices, etc. – col. 8, lines 11-18.

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify Inoue's system to include a mobile data receiver, as

taught by Shimakawa for the advantage of providing mobility to the user.

As for claim 20, Inoue and Shimakawa disclose:

a persistence means (Inoue, 3 – Fig. 1) for storing the data sets selected by said

filtering means to said removable storage device (The receiver (3 – Fig. 1) records data

brought in from an external device (30-45 – Fig. 1) to the removable storage device

(100 – Fig. 3) – Inoue, col. 19, lines 3-16).

As for claim 21, Inoue and Shimakawa disclose:

derivation means(Inoue, 30 – Fig. 1) for computing derivatives from the

elements of the data sets selected by said filtering means, wherein the instructions for

computing said derivatives are loaded from said removable storage device by said

mobile receiver ((The user is outputted with user-specific information based on the

program which is loaded from the removable storage device (100 – Fig. 1) which stores

what type of information needs to be extracted for the particular user – Inoue, col. 10,

lines 30-53)); and

wherein said output means (monitor receiver) outputs said derivatives to the user

– Inoue, col. 8, lines 6-12, col. 10, lines 45-50.

As for claim 22, Inoue and Shimakawa disclose:

a persistence means (3 – Fig. 1) for storing said derivatives computed by said derivation

means to said removable storage device (The receiver (3 – Fig. 1) records data brought

in from an external device (30-45 – Fig. 1) to the removable storage device (100 – Fig.

3) – Inoue, col. 19, lines 3-16).

3. Claims 4, 6, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Inoue in view of Shimakawa as applied to either claims 1, 5, or 10 above, and

further in view of Sezan.

Considering claim 4, Inoue and Shimakawa fail to disclose an apparatus wherein

said embedded computer includes a signaling means for alerting the user that

demodulated digital data is available.

In an analogous art, Sezan discloses an apparatus wherein said embedded

computer includes a signaling means for alerting the user that demodulated digital data

is available (An intelligent agent alerts the users of programs that would be of interest to

the user based on saved preferences - col. 11, lines 55-61. The intelligent agent is

included in the SFB module – col. 9, lines 13-15).

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify Inoue's system to include an apparatus wherein said

embedded computer includes a signaling means for alerting the user that demodulated

digital data is available, as taught by Sezan for the advantage of providing the user the

ease of not having to search oneself to see if demodulated data is available or not.

Considering claim 6, Inoue and Shimakawa fail to disclose an apparatus wherein

said video display comprises a pacing means for displaying content with a plurality of

pause lengths.

In an analogous art, Sezan discloses an apparatus wherein said video display comprises a pacing means (<FrameFrequency descriptor>) for displaying content with a plurality of pause lengths (col. 22, lines 24-27).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Inoue's system to include an apparatus wherein said video display comprises a pacing means for displaying content with a plurality of pause lengths, as taught by Sezan for the advantage of providing the user the option to view a program at a desirable pace.

Considering claim 7, Inoue and Shimakawa fail to disclose an apparatus wherein said pacing means includes selection of pause lengths through parameters stored on said removable storage device.

In an analogous art, Sezan discloses an apparatus wherein said pacing means (<Frame Frequency> descriptor) includes selection of pause lengths through parameters stored in the software stored on said removable storage device. (The user selects one's preferences through the user description scheme – col. 11, lines 43-47. The user's preferences are stored on the removable storage device- col. 10, lines 40-47. The descriptor <FrameFrequency> specifies at what interval the frames should be displayed – col. 22, lines 24-27).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include an apparatus wherein said pacing means includes selection of pause lengths through software stored on said removable storage device,

as taught by Sezan for the advantage of providing the user selection means to view a

program at a desirable pace.

As for claim 13, Inoue and Shimakawa fail to disclose wherein said interactive

computer includes a synchronizing means for synchronizing personalization parameters

stored on said removable storage device with the personalization parameters used by

an interactive television service.

In an analogous art, Sezan discloses a system (figure 2) wherein the computer

includes a synchronizing means (SFB) for synchronizing personalization parameters

stored on said removable storage device with the personalization parameters used by

an interactive television service (The user description scheme comprises of user's

preferences (personalization parameters) and is stored on the removable storage

device. The program description scheme comprises of video, still image, and/or audio

information namely, program views and program profiles – col. 4, lines 40-44. The

software agent performs a search and filtering for the user using the user description

scheme and the program description scheme information to output desirable content –

col. 5, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify Inoue's system to include a synchronizing means for

synchronizing personalization parameters stored on said removable storage device with

the personalization parameters used by an interactive television service, as taught by

Sezan for the advantage of providing an effective method of filtering out broadcast data

based on user's preferences.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view

of Shimakawa as applied to claim 1 above, and further in view of Beach.

Considering claim 8, Inoue and Shimkawa fail disclose an apparatus comprising

of an audio output system including a voice synthesizer for converting digital data to

analog audio signals.

In an analogous art, Beach discloses an application of a mobile device which has

a voice synthesizer which can read out messages received (col. 6, lines 63-67, col. 8,

lines 11-17).

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify Inoue and Shimakawa's invention to include an audio

output system including a voice synthesizer for converting digital data to analog audio

signals as taught by Beach, for the advantage of providing the user with the convenient

function of having text data converted to an audio output.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view

of Shimakawa as applied to claim 1 above, and further in view of Piccionelli.

As for claim 9, Inoue and Shimakawa fail to disclose wherein said mobile receiver is embedded within a personal stereo.

In an analogous art, Piccionelli discloses wherein mobile receivers are integrated into personal stereos for the advantage of providing versatility to the user – [0046].

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Inoue and Shimakawa's invention to include wherein mobile receivers are integrated into personal stereos, as taught by Piccionelli, for the advantage of providing versatility to the user.

6. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Shimakawa as applied to claim 1 or 10 above, and further in view of Torri.

As for claims 17 and 18, Inoue and Shimakawa, in particular, Inoue discloses wherein said embedded computer loads data from said removable storage device as discussed above, but fails to disclose wherein it loads firmware updates for said embedded computer.

In an analogous art, Torii discloses wherein firmware updates are loaded for the advantage of updating devices with the latest software – col. 2, lines 14-16, col. 3, lines 1-10.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Inoue's invention to include wherein firmware updates

are loaded, as taught by Torri, for the advantage of updating devices with the latest

software.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sumaiya A. Chowdhury whose telephone number is

(571) 272-8567. The examiner can normally be reached on Mon-Fri, 9-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chris Grant can be reached on (571) 272-7292. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

SAC

CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800